

In re Appln. of CHAWLA et al.
Application No. 10/008,489

REMARKS

Reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

Summary of the Application

Claims 1-3, 5-24, 26-32, 34, 35, 37, 38, 40, 41, 43-49, 51, 52, 54, 55, 57, 58 and 60-65 are currently pending.

Summary of the Office Action

The Action initially enters a rejection against claims 1-65 under Section 112, second paragraph, arguing that the terms "photoinitiator" and a component selected from the group consisting of . . ." are indefinite because they may read upon one another.

Claims 1-65 are further rejected as obvious over Ha et al. or WO '368.

Discussion

At the outset, applicants have addressed the Section 112 rejection by clarifying the claimed subject matter. Specifically, applicants have segregated the photoinitiator and corrosion-inhibitor components by referring to a component comprising a photoinitiator and a corrosion-inhibitor component. One skilled in the art upon reading the claims would understand that the claims require a component that includes a photoinitiator and another, separate component that functions as a corrosion-inhibitor.

The argument in the Action that there exists a component that may function as a photoinitiator and a corrosion-inhibitor is of no consequence relative to Section 112. Section 112 only requires that the claims be sufficiently clear so that one skilled in the art can determine the scope of the claims, e.g., whether an infringement issue exists. No more is required under the law. As the claims clearly meet this standard, Applicants submit that the Section 112 rejection should be withdrawn.

Turning to the substantive aspects of the Action, it is suggested therein that Ha et al. or WO '368 teach the inclusion of from 0.1 to 15 wt.% of a photoinitiator, this amount including mercaptobenzothiozoles or mercaptobenzooxazoles as claimed. Applicants submit that this does not fairly describe the teaching provided by the references when viewed in their entirety, and that the obviousness rejection should be withdrawn.

In the cited prior art, there is no distinction drawn between the corrosion-inhibitors claimed in the present application and any other photoinitiator. Indeed, the references teach

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that any single or combination of photoinitiators may be used in the formulation. This general description is insufficient to teach or suggest the selective use of various components as required by the claims. Specifically, the prior art does not include any teaching which would motivate one skilled in the art to select and include in the claimed composition a photoinitiator and another component, i.e., a corrosion-inhibiting component, wherein the latter is selected and included in an amount that does not reduce the cure rate or overall cure of the composition.

Even assuming the prior art teaches the use of both a photoinitiator component and a corrosion-inhibiting component, a fair reading of the prior art references would motivate one skilled in the art to use far more of only one of these components than is required by the claims. The Examples in the prior art references, for example, which provide actual formulations that would provide the most useful teaching to those skilled in the art, fail to disclose the use of any mercaptobenzothiozole or mercaptobenzoxazole at all. In fact, the examples are limited to teaching the use of relatively high amounts of standard photoinitiators, e.g., Irgacure, Darocure, at 4 wt.% (Example 1), 6.5 wt.% (Examples 2, 5 and 6), 3 wt.% (Example 3), 8.5 wt.% (Example 4), 6 wt.% (Example 7), 6.25 wt.% (Examples 8-10). To the extent that the Action equates photoinitiator and corrosion-inhibitor components (to which applicants disagree), this teaching clearly motivates one skilled in the art to use these components, including corrosion-inhibitors, in amounts that far exceed the claimed amounts. Indeed, applicants have demonstrated that the use of corrosion-inhibitors in the amounts taught by the prior art reduce the cure rate and overall cure of the composition—a problem that was discovered by applicants, and that is avoided by following the claimed invention.

Thus, the prior art teaches away from the claimed invention, in which the corrosion-inhibitor is limited to no more than about 0.1 wt.%, or less (in other claims), so that the cure rate and overall cure is not reduced. There is no recognition in the prior art references that excessive amounts of the claimed corrosion-inhibitors would have an adverse impact on certain properties of the prior art compositions, and thus one skilled in the art would not be motivated to provide a composition that includes both a photoinitiator and a corrosion-inhibiting compound, wherein the latter is present at no more than 1 wt.%, the amount further no reducing the cure rate or overall cure of the composition..

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

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Examiner, a telephone conference would expedite the prosecution of the subject application,
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Christopher T. Griffith, Reg. No. 33,392
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: February 17, 2005

Amendment or ROA - Regular (Revised 11-23-04)